

REMARKS

Claims 1-8, 12-15, 18-24, and 81-83 are pending in the present application. Further examination and reconsideration of pending claims 1-8, 12-15, 18-24, and 81-83 are respectfully requested.

Rejection under 35 U.S.C. § 102(f)

Claims 1-2, 4-5, 12-15, 18, and 21-24 were rejected under 35 U.S.C. § 102(f) because the applicant allegedly did not invent the claimed subject matter. As will be set forth in detail below, the § 102 rejections of claims 1-2, 4-5, 12-15, 18, and 21-24 are respectfully traversed.

The Office Action states that "Cronenberg et al., US 6,749,812 clearly discloses the invention claimed by applicant as disclosed there in and illustrated in figures 3A-D. The inventors of the patent are different from the inventors of the instant application." (Final Office Action -- page 4). Applicants respectfully traverse this assertion. In particular, although the inventors of U.S. Patent No. 6,749,812 to Cronenberg et al. (hereinafter "Cronenberg") are different than the inventors of the instant application, Cronenberg states:

FIGS. 3A-3D illustrate still another embodiment of the invention, which embodiment is utilized in conjunction with a pipette of the type described in application Ser. No. 09/873,522 of the applicant entitled HAND HELD PIPETTE which is being filed concurrently herewith. (Cronenberg -- col. 6, line 65 to col. 7, line 2).

Therefore, Cronenberg specifically discloses that the pipette shown in Figs. 3A-3D of Cronenberg and the corresponding description of the pipette is the work of the Applicants of the instant application -the application serial number 09/873,522 referenced in Cronenberg is indeed the serial number for this very application.

In addition, as is clear from the description of Figs. 3A-3D of Cronenberg (e.g., Cronenberg -- col. 6, line 65 to col. 7, line 21), Cronenberg describes an embodiment of the invention of Cronenberg configured for utilization with the pipette of the type described in the instant application. Therefore, Cronenberg clearly does not disclose the pipette as the invention of Cronenberg, but merely discloses the pipette as being used with an embodiment of the invention of Cronenberg. As such, upon consideration of the content and nature of Cronenberg, as well as the circumstances surrounding its publication, not merely its authorship, no question at all can be raised as to whether the Applicants are the inventors of

the presently claimed subject matter. "For example, if the author (whether he is the applicant or not) specifically states that he is describing the work of the applicant, no question at all is raised. The content and nature of the printed publication, as well as the circumstances surrounding its publication, not merely its authorship, must be considered." *In re Katz*, 215 U.S.P.Q. 14, 687 F.2d 450 (C.C.P.A. 1982).

In other words, since Cronenberg identifies the inventorship of the subject matter disclosed in Cronenberg and being claimed in the instant application undergoing examination as the inventorship of the instant application, the designation of the inventorship in Cronenberg does not raise a presumption of inventorship with respect to the subject matter disclosed but not claimed in Cronenberg so as to justify the present rejection under 35 U.S.C. § 102(f). Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent or an application publication identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter

disclosed but not claimed in the patent or published application so as to justify a rejection under 35 U.S.C. 102(f). MPEP 716.10.

See also *In re Land*, 54 C.C.P.A. 806, 151 U.S.P.Q. 621, 368 F.2d 886 (1966). "The sole evidence was Clifford's patent application. If that application had said, in the course of describing another invention on which Clifford got his patent, that it was describing in addition an invention of Whitford, which would more resemble the case we had in *Blout*, it would not have been evidence that Clifford, or anyone else, knew the invention Whitford made *before* he made it." (emphasis in original). In this case, since Cronenberg has said, in the course of describing another invention on which Cronenberg got his patent, that it was describing in addition the invention of Applicants, it is not evidence that Cronenberg, or anyone else, knew the invention of Applicants before they made it.

See also *In re Blout*, 142 USPQ 173 (C.C.P.A. 1964). "Rule 79 states: 79. *Reservation clauses not permitted.* A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application, but an application disclosing unclaimed subject matter may contain a reference to a later filed application of the same applicant or owned by a

*common assignee disclosing and claiming that subject matter.*" (emphasis in original). It is noted that although Cronenberg and the instant application are not by the same applicant, Cronenberg and the instant application are owned by the same assignee (Vistalab Technologies, Inc.). In addition, Cronenberg does not include a reservation clause not permitted by Rule 79. However, Cronenberg in disclosing the unclaimed subject matter of the pipette shown in Figs. 3A-3D contains a reference to the instant concurrently filed application owned by the same assignee disclosing and claiming that subject matter in accordance with Rule 79.

See also *Ex parte Lemieux*, 115 USPQ 148 (Bd. Pat. App. & Int. 1957). "In the former decision it was held that 'this rule [Rule 131] presupposes that the printed publication is the publication by some one other than the applicant whose application is rejected-by some one who asserts inventorship therein either in himself or some other person than the applicant.' In the later case it was held that the rule is not 'intended to apply to a case where the publication appears without question to be a publication of the applicant's own invention.'" In this case, Cronenberg does not assert therein inventorship, either in himself or some other person, of the pipette shown in Figs. 3A-3D. In fact, Cronenberg clearly and

without question discloses that the pipette shown in Figs. 3A-3D is that disclosed in the instant application and thereby attributes inventorship of the pipette to Applicants of the instant application. Therefore, this rule does not apply to this case in which Cronenberg contains without question a publication of the invention of Applicants of the instant application.

Since Cronenberg contains an unequivocal reference to the instant application as being the application in which the pipette of the type shown in Figs. 3A-3D is described, there can be no doubt that Cronenberg is not *prima facie* available as a reference against the instant application. In particular, by referencing the instant application, Cronenberg explicitly disclaims inventorship of the specific subject matter related to the pipette shown and described in Figs. 3A-3D on which the Examiner relies for the section 102(f) rejection of claims 1-2, 4-5, 12-15, 18, and 21-24. In contrast to this case in which there is a reference to the instant application in Cronenberg, in cases in which no such reference was included or possible, the prior art was determined to be *prima facie* available as a reference against the application being examined.

"Engalitcheff contains no reservation clause since it is prohibited by Rule 79, and, of course, there could be no

reference to the appellant's *application* in Engalitcheff as permitted by that rule since appellant had not yet filed when Engalitcheff issued. In fact, there is nothing in the *Engalitcheff* patent itself to the effect that the water distribution box was not invented by Engalitcheff or is to be attributed to anyone else. Thus, there can be no doubt that Engalitcheff is *prima facie* available as a reference against appellant." *In re Facius*, 161 USPQ 294 (C.C.P.A. 1969). (emphasis in original) In this case, there can be no such doubt that Cronenberg is available as a reference against the instant application due to the reference in Cronenberg to Applicants' instant application.

Since Cronenberg is not *prima facie* available as a reference against the instant application, there is no further burden on Applicants to establish any facts necessary to overcome that patent. "Since the patent is *prima facie* available as a reference against appellant, the burden is on appellant to establish the *facts* necessary to 'overcome' that patent." *In re Facius*, 161 USPQ 294 (C.C.P.A. 1969). (emphasis in original).

Moreover, even if Cronenberg claimed the presently claimed pipette in combination with other subject matter, the existence

of combination claims does not evidence inventorship of the presently claimed subject matter by Cronenberg of the individual elements or sub-combination thereof if the latter are not separately claimed apart from the combination. As is clear from claims 1-27 of Cronenberg, Cronenberg does not claim the pipette of the instant application separately apart from any combination thereof. Therefore, the claims of Cronenberg do not evidence inventorship of the presently claimed subject matter. "[T]he existence of combination claims does not evidence inventorship by the patentee of the individual elements or sub-combination thereof if the latter are not separately claimed apart from the combination. It is clear that the inventor of a combination may not have invented any element of that combination, much less each of the elements." *In re De Baun*, 214 U.S.P.Q. 933, 687 F.2d 459 (C.C.P.A. 1982). (emphasis in original).

Since there is no ambiguity created by Cronenberg as to the inventorship of the presently claimed subject matter, it is not incumbent upon Applicants to provide any further showing that Applicants are the sole inventor of the presently claimed subject matter. "Where there is an ambiguity created by the printed publication it becomes incumbent on the applicant to



provide a satisfactory showing which would lead to a reasonable conclusion that this is the sole inventor." *In re Katz*, 215 U.S.P.Q. 14, 687 F.2d 450 (C.C.P.A. 1982).

For at least the reasons set forth above, there is no evidence that the Applicants of the instant application have derived the invention, as defined in the present claims, from another. Accordingly, the section 102(f) rejections of claims 1-2, 4-5, 12-15, 18, and 21-24 cannot be sustained. "Paragraph (f) was historically considered as a section compelling the inventor to be the party applying for a patent and traditionally is applicable in the situation where an applicant has derived an invention from another. Here there is no evidence that the invention, as defined by the claims, has been derived from another. Accordingly, the rejection of [the claims] under 35 U.S.C. 102(f) will not be sustained." *Ex parte Billottet*, 192 USPQ 413 (Bd. Pat. App. & Int. 1976).

For at least the reasons set forth above, Applicants did invent the subject matter recited in claims 1-2, 4-5, 12-15, 18, and 21-24 sought to be patented. Accordingly, removal of the § 102 rejections of claims 1-2, 4-5, 12-15, 18, and 21-24 is respectfully requested.

Rejection under 35 U.S.C. § 103(a)

Claims 6-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cronenberg in view of U.S. Patent No. 2,796,204 to Math (hereinafter "Math"). As will be set forth in detail below, the § 103 rejections of claims 6-8 are respectfully traversed.

Cronenberg is not available as prior art for § 103 rejections of the present claims. As noted above, claims 6-8 were rejected over a combination of Cronenberg and other cited art. However, 35 U.S.C. § 103(c) recites, in part:

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

It is noted that the instant application claims priority to U.S. Patent Application Serial No. 60/214,143 filed June 26, 2000. Since Cronenberg has an effective filing date of June 26, 2000, Cronenberg is available as prior art against the present claims only under 35 U.S.C. §§ 102(f) and (g). In addition, it is noted that at the time the presently claimed

invention was made, the subject matter of Cronenberg and the presently claimed invention were owned by or subject to an obligation of assignment to the same assignee (Vistalab Technologies). Accordingly, the undersigned attorney of record for the instant application hereby states, in a clear and conspicuous manner, that the instant application and Cronenberg, at the time the invention of the instant application was made, were owned by Vistalab Technologies. This statement alone is sufficient evidence to disqualify Cronenberg from being used in a rejection under 35 U.S.C. § 103(a) against the claims of the instant application. MPEP 706.02(1)(2)(II). Consequently, Cronenberg is not available as prior art for § 103 rejections of claims of the instant application.

Since Cronenberg is not available as prior art for § 103 rejections of the present claims, no combination of Cronenberg with other art (e.g., Math) may be used for § 103 rejections of the present claims. Accordingly, removal of the § 103 rejections of claims 6-8 is respectfully requested.

**Lack of Support for Rejections of Claims 81-83**

The Office Action Summary indicates that claims 81-83 stand rejected. However, no basis for the rejections of claims 81-83 has been provided in the Final Office Action. Accordingly, Applicants respectfully request clarification as to the status of claims 81-83 in the next communication from the Office. In addition, Applicants respectfully submit that claims 81-83 are allowable for at least the reasons set forth herein.

**Allowable Subject Matter**

Claims 3 and 19-20 were objected to as being dependent upon a rejected base claim, but were deemed allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants appreciate the Examiner's recognition of allowable subject matter and await allowance of the remaining claims in the case.

**Conclusion**

This communication is believed to be fully responsive to the Final Office Action mailed February 4, 2008, and every effort has been made to place the application in condition for allowance. In addition, the art cited but not relied upon is

not believed to be pertinent to the patentability of the present claims. The claims are believed to be patentable over the cited references, and a favorable Office Action is hereby earnestly solicited.


If a telephone interview would be of assistance in advancing prosecution of the present application, the Examiner is respectfully invited to telephone the undersigned at the number provided below.

If any fee is due in connection with the present response, the Commissioner for Patents is hereby authorized to charge the requisite fee to our deposit account number 02-0393.

Respectfully submitted,

Date 4/3/2008

By:

  
Frank M. Gasparo  
Registration No. 44,700  
Baker & McKenzie LLP  
1114 Avenue of the Americas  
New York, NY 10036  
Telephone (212) 626-4100  
Facsimile (212) 310-1600